

REMARKS/ARGUMENTS

Applicants have studied the Office Action dated November 30, 2005. Applicants respectfully request entry of these remarks under the provisions of 37 C.F.R. § 1.116(a) in that the remarks below place the application and claims in condition for allowance, which allowance is respectfully requested. Claims 1 - 22 are pending. Reconsideration and allowance of the claims in view of the following remarks are respectfully requested.

Applicants submit that this response does not raise new issues in the application. It is submitted that the present response places the application in condition for allowance or, at least, presents the application in better form for appeal. Entry of the present response is therefore respectfully requested.

Applicant has studied the Office Action dated November 30, 2005. It is submitted that the application, as previously amended, is in condition for allowance. Claims 1-23 remain pending. Reconsideration and allowance of the pending claims in view of the following remarks is respectfully requested.

Rejection under 35 U.S.C. §103(a)

In items 1 and 2 of the Office Action, the Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Culliss (U.S. Patent No. 6,539,377) in view of Gormley et al. (U.S. Patent No. 5,628,004) and further in view of Walker et al. (U.S. Patent No. 5,862,223).¹

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Independent claim 1 recites, *inter alia*:

receiving a Uniform Resource Locator (URL) string from

¹ Applicants make no statement as to whether such a combination is even proper.

first a user;

determining if the URL string represents a query, if the URL string represents a query, performing the sub-steps of:

...

storing information in an accounting database for awarding the first user for submitting the query for sharing; and
receiving, from a second user, a selection for one of the stored queries for sharing in the database. (emphasis added)

Independent claim 14 recites, *inter alia*:

an input for **receiving a Uniform Resource Locator (URL) string from a first user;**

a comparator for determining if the URL string represents a query;

...

an output for forwarding the query to a hub processing unit in the event that the first user selects the [[a]] query for sharing with a second user connected to the hub processing unit;

an accounting database for **storing information for awarding the first user for submitting the query for sharing;** and

....

Independent claim 22 recites, *inter alia*:

reception instructions for receiving **a Uniform Resource Locator (URL) string from a first user;**

determination instructions for determining if the URL string represents a query;

storing instructions for storing the query in a client computer if the URL string represents a query;

...

storing information in an accounting database for **awarding the first user** for submitting the query for sharing; and

receiving, from a second user, a selection for one of the stored queries for sharing in the database. (emphasis added)

The present invention provides a system and method for sharing web-based search engine queries. A first user creates a search string and stores the string in a database for future use by a second user. Page 11, lines 4-5 of the instant specification. The submission is then recorded and kept in an accounting database for awarding the first user for sharing his search string, thereby ensuring that the user receives some recognition for his donation in the form of points or some other award. Page 11, lines 2-8 of the instant specification.

As the Examiner correctly states on page 3 of the Office action, Culliss does not explicitly disclose *"receiving, from a second user, a selection for one of the stored queries for sharing in the database"*. The Examiner goes on to combine Gormley et al.²

The present invention, in contrast to Gormley et al., is implemented between a web browser and the World Wide Web, i.e., fully web related. Page 9 of the instant application.

As the Examiner correctly points out on page 3 of the Office Action, neither Culliss nor Gormley et al. teach, mention, or suggest *storing information in an accounting database for awarding the first user for submitting the query for sharing*, as recited in independent claims 1, 14, and 22 of the instant application. The Examiner goes on to combine Walker.³

Walker discloses a system for rewarding experts for answering questions submitted by users of a computer system. Walker, col. 21, lines 65-67. In Walker, a "end user" submits a request for information to central controller (200). Walker, col. 21, lines 13-14. The controller generates a price for the end user's request and attaches it to the request. *Id.* Both the end user request and price are then transmitted to a qualified expert. Walker, col. 21, lines 18-20. The central controller pays the expert for providing an answer when the end user's request is sent to the expert or upon being notified that the end user is satisfied with the answer. Walker, col. 22, lines 51-59. The transaction described in Walker does not vary from many transactions found in other areas of commerce. In other words, Walker merely describes a buyer (the end user) offering to pay a price for a service (answering a question) performed by an Expert. Stated differently, if the Walker invention and the present invention were classified ads in the newspaper, the ads would be listed in different categories. Specifically, the present invention would be in the products section and would be a product (a stored query)

² Applicants make no statement as to whether such a combination is even proper.

³ Applicants make no statement as to whether such a combination is even proper.

advertised for a price (reward for the user submitting). In contrast, the Walker invention would be in a services section of ads placed by those that are seeking, and offering to pay, others to perform a desired service (answering questions).

In the present invention, the "first user" is a person that submits a URL string. Walker discusses URLs but the Expert in Walker is not the person that submits a URL string (i.e, query). The Expert in Walker is a person responding to questions submitted by the end user, which is most analogous to the "first user" recited in the claims of the instant application. Clearly, the subject matter of Walker is the answers submitted by the Expert, whereby these answer are used to generate fees from the end users. Accordingly, Walker does not "stor[e] information in an accounting database for awarding the [Expert] for submitting the [URL string] for sharing," as recited in claims 1, 14, and 22 of the instant application, because the Expert didn't submit the URL string.

Substituting the Expert in Walker with the first user in the present invention renders the present invention inoperable. References that produce seemingly inoperative devices cannot serve as predicates for a prima facie case of obviousness.⁴

A person skilled in the art would have had to turn away from the important aspects in Walker in order to exchange Walker's expert responding to pre-posed question the user submitting a URL that is determined to be a query of the present invention. Consequently, a person skilled in the art would have no suggestion or motivation to combine Walker with Culliss and Gormly as stated by the Examiner on page 4 of the Office action. Applicants hereby submit that for such a substantial modification of the structure of Walker, a motivation would have indeed had to have been necessary which the Examiner would have had to prove with the help of additional relevant prior art references.

⁴ Michael L. McGinely versus Franklin Sports, Inc. (Fed Cir 2001) ("If references taken in combination would produce a 'seemingly inoperative device,' we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness."); In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see also In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

When there is no suggestion or teaching in the prior art for "*determining if the URL string represents a query...and forwarding the query... for sharing*" or for "*activating a hyperlink to request a search result set upon user selection of the hyperlink*" or for "*storing information in an accounting database for awarding the first user for submitting the query for sharing*" the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Culliss taken alone and/or in view of Gormley et al. and/or in view of Walker does not teach, mention, or even suggest "*determining if the URL string represents a query...and forwarding the query... for sharing*" or for "*activating a hyperlink to request a search result set upon user selection of the hyperlink*" or for "*storing information in an accounting database for awarding the first user for submitting the query for sharing*" Accordingly, claims 1, 14, and 22 distinguish over Culliss taken alone and/or in view of Gormley et al. and/or in view of Walker for this reason as well.

Continuing on, independent claim 9 recites, *inter alia*:

receiving a query selected for sharing by a first user of a client information processing system;

...

storing information in an accounting database for awarding the first user for submitting the query for sharing;

receiving from a second user a selection of the query shared by the first user;

... (emphasis added)

Independent claim 21 recites, *inter alia*:

an input means for receiving from a client over a network, a query selected by a first user for sharing;

interface means for storing the query received;

means for searching through queries by a second user;

means for finding an interesting shared query by the second user;

means for activating a hyperlink to request a result set if the shared query is of value to the second user;

means for awarding the first user for selecting the query for sharing; and
means for perusing the search result set if the shared query is of value to the second user. (emphasis added)

As the Examiner correctly points out on page 9 of the Office Action, neither Culliss nor Gormley et al. teach, mention, or suggest *means for awarding the first user for selecting the query for sharing*, as recited in independent claim 9 of the instant application. The Examiner goes on to combine Walker.⁵

The teachings of Walker are described above. Walker does not follow the steps of claims 9 and 21 of the instant application. Claim 9 recites "receiving a query selected for sharing by a first user of a client information processing system" and claim 21 recites "input means for receiving from a client over a network, a query selected by a first user for sharing."

In Walker an end user submits a question. Therefore, the "end user" in Walker would be the most similar to the "first user" in claims 9 and 21 of the instant application. Claim 9 goes on to say: "storing information in an accounting database for awarding the first user for submitting the query for sharing" and claim 21 recites "means for awarding the first user for selecting the query for sharing." However, it is the expert that is rewarded in Walker and not the end user, or "first user." In Walker, the end user is the one that pays for the Expert's answer. Clearly, Walker does not show "storing information in an accounting database for awarding the first user for submitting the query for sharing" as recited in claim 9 or "means for awarding the first user for selecting the query for sharing" as recited in claim 21 of the instant application.

A person skilled in the art would have had to turn away from the important aspects in Walker in order to exchange the expert with a user submitting a URL that is determined to be a query. Consequently, a person skilled in the art would have no suggestion or motivation to combine Walker with Culliss and Gormly as stated by the Examiner on

⁵ Applicants make no statement as to whether such a combination is even proper.

page 4 of the Office action. Applicants hereby submit that for such a massive change of the structure of Walker, a motivation would have indeed had to have been necessary which the Examiner would have had to prove with the help of additional relevant prior art references.

When there is no suggestion or teaching in the prior art for *"receiving a query selected for sharing by a first use"* and for *"storing information in an accounting database for awarding the first user for submitting the query for sharing"* or for *"input means for receiving from a client over a network, a query selected by a first user for sharing"* and *"means for awarding the first user for selecting the query for sharing,"* the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Culliss taken alone and/or in view of Gormley et al. and/or in view of Walker does not teach, mention, or even suggest *"receiving a query selected for sharing by a first use"* and for *"storing information in an accounting database for awarding the first user for submitting the query for sharing"* or for *"input means for receiving from a client over a network, a query selected by a first user for sharing"* and *"means for awarding the first user for selecting the query for sharing."* Accordingly, claims 9 and 21 distinguish over Culliss taken alone and/or in view of Gormley et al. and/or in view of Walker for this reason as well.

It is accordingly believed to be clear that Culliss, whether taken alone or in any combination with Gormley et al. and/or Walker, neither shows nor suggests the features of claims 1, 9, 14, 21, or 22. Claims 1, 9, 14, 21, and 22 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claims 1, 9, 14, 21, and 22

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

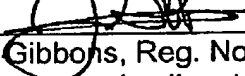
Applicant acknowledges the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

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Respectfully submitted,

By: 
Jon Gibbons, Reg. No. 37,333
Attorney for Applicants

FLEIT, KAIN, GIBBONS, GUTMAN BONGINI & BIANCO P.L.
551 N.W. 77th Street, Suite 111
Boca Raton, FL 33487
Tel (561) 989-9811, Fax (561) 989-9812

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